

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Frank Muir

Confirmation No. 3860

Serial No. 10/807,411

Group Art Unit 1732

Filed March 24, 2004

Examiner Matthew Daniels

For BOTTLE CAP WITH BUILT-IN MAGNIFICATION

Box AF

Commissioner for Patents

PO Box 1450

Alexandria, Virginia 22313-1450

AMENDMENT AFTER FINAL REJECTION UNDER 37 C.F.R. § 1.116

Sir:

In response to the Office Action mailed June 8, 2006, the undersigned requests entry of the following amendment to eliminate one of the rejections lodged in the case, and consideration of the following remarks to place place the application in condition for allowance:

Listing of the Claims: begins on page 2

Remarks: begin on page 4

BOX "AF"
RESPONSE UNDER 37 C.F.R. § 1.116
---EXPEDITE PROCEDURE---
EXAMINING GROUP 1732

Listing of the Claims:

The following is a complete listing of all the claims in the application, with an indication of the status of each:

1. (Currently amended) A method of making bottle caps, each having a built-in magnification feature, comprising the steps of:

selecting a radius of curvature for at least one of an upper or lower convex surface of a top portion of each bottle cap of a plurality of bottle caps ~~to be made based on a diameter of each bottle cap~~ wherein different radiuses are selected for different diameter bottle caps of said plurality of bottle caps; and

for each bottle cap to be made, pressing a single piece of plastic that is in the shape of a bottle cap, or will be formed into the shape of a bottle cap, having said top portion and an annular bottle engaging portion which includes either thread engaging members or a lid wall with an inwardly projecting hook region at its base for selectively affixing the bottle cap to a top of a bottle, wherein said at least one of said upper or lower convex surfaces of said top portion of each bottle cap of said plurality of bottle caps to be made has said radius of curvature selected in said selecting step so as to provide optical magnification of objects viewed through said top portion.

2. (Original) The method of claim 1 wherein said pressing step is achieved using a stamping machine.

3. (Original) The method of claim 1 wherein said annular bottle engaging portion includes thread engaging members.

4. (Original) The method of claim 1 wherein said annular bottle engaging portion includes a lid wall with an inwardly projecting hook region at its base.

5-6. Canceled

7. (Previously presented) The method of claim 1 wherein said top portion of each

bottle cap to be formed has both a convex upper surface and a convex lower surface each of which has an equal radius of curvature.

8. (Previously presented) The method of claim 1 wherein said top portion of each bottle cap to be formed has both a convex upper surface and a convex lower surface each of which has a different radii of curvature.

9. (Previously presented) The method of claim 1 wherein at least one surface of said top portion is flat.

10. (Previously presented) The method of claim 1 wherein said single piece of plastic is transparent.

11. (Previously presented) The method of claim 1 wherein said single piece of plastic is translucent.

12-16. Canceled

17. (Previously presented) The method of claim 1 wherein said at least one of said upper or lower convex surfaces has a perimeter which extends to an edge of said annular bottle engaging portion.

18. (Previously presented) The method of claim 1 wherein said step of pressing simultaneously forms the annular bottle engaging portion and said top portion having said at least one upper or lower convex surface.

REMARKS

Claim 1 has been amended. All other claims remain unchanged. The application now includes claims 1-4, 6-11, and 17-18.

All claims were rejected as being indefinite under 35 U.S.C. 112, second paragraph. The undersigned disagrees and is of the opinion that having the curvature of the lens being based on the diameter of the bottle cap would be well understood by those of skill in the art particularly in view of the teachings on page 7 lines 9-25. However, to advance prosecution of the case and to either place it in immediate condition for allowance or to reduce the number of issues for appeal, the “based on” language has simply been eliminated from claim 1, as this language is not required to distinguish the prior art of record. Due to the reduction in issues which may require appeal, entry of this amendment at this time is appropriate.

Claims 1-3, 7-11 and 18 are rejected as being obvious over Owens; claim 4 is rejected as being obvious over a combination of Owens and Towns; and claim 17 is rejected as being obvious over a combination of Owens and Harris. Each of these rejection is traversed.

While the undersigned does not agree that the Owens device can be used as a bottle cap, or that certain features of the recited claims do not provide patentable weight to the claimed method, the undersigned notes that the claimed method is not obvious over any of the references of record, alone or in combination. In particular, the claimed method is focused on a method of making bottle caps, and requires

“selecting a radius of curvature for at least one of an upper or lower convex surface of a top portion of each bottle cap of a plurality of bottle caps wherein different radiuses are selected for different diameter bottle caps of said plurality of bottle caps” (emphasis added)

As the Examiner recognizes, Owens does not show or discuss making bottle caps (hence the reasoning that the Owens device could be used as bottle cap-to which the undersigned disagrees). Rather, Owens shows making very precise lens devices for measuring instruments. At no point does Owens show or describe making a plurality of lenses where different diameter lenses have different radiuses

of curvature. Rather, each lens design shown or described in Owens is singular in nature, and all that might be suggested from Owens is that additional lenses of identical radiuses can be produced.

As discussed during the Interview, pill bottles distributed at pharmacies come in different sizes. The process disclosed and claimed in the invention allows a plurality of bottle caps to be produced, and to have the different bottle caps be pressed in a manner whereby different radiuses of curvature selected for each different sized cap are formed in the different sized caps. This type of methodology allows mass production of bottle caps which would be used on different sized pill bottles. The Owens methodology is not suited for mass production and is focused on making precision ocular devices which fit into specific instruments. Thus, while a radius may be provided in Owens, Owens by no means shows or suggests different radiuses being selected for different diameter bottle caps of said plurality of bottle caps. Similarly, neither Towns nor Harris suggest or make obvious this missing feature of Owens. That is, both Towns and Harris show manufacturing of one type of device (a bottle cap of one dimension in the case of Towns, and a lens for a storage device in the case of Harris). In view of this, no combination of Owen, Towns or Harris would make any of the claims obvious to one of ordinary skill in the art. Simply put, the high volume production of bottle caps having viewing devices that are fabricated by a pressing operation would not be obvious to one of ordinary skill in the art based on any combination of references of the art of record.

With respect to the translucency requirement of claim 11, the previous response provided a text book definition demonstrating that a translucent material is known by those of ordinary skill in the art to have different properties than a transparent material. The Owens device would never be made with a translucent material.

In view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 1-4, 6-11, and 17-18 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local

telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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